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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,840	12/21/2001	Lisa Baker	PGI6044P0780US	4948

32116 7590 02/26/2007
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

EXAMINER

STEPHENS, JACQUELINE F


ART UNIT	PAPER NUMBER
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3761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s) 	
	10/036,840	BAKER, LISA	
	Examiner	Art Unit	
	Jacqueline F. Stephens	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/21/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/21/06 have been fully considered but they are not persuasive. Applicant repeats the argument that the odor control compound of Nakamura is present as a coating at the surface of the substrate material by having been topically applied. The examiner points to the Nakamura reference, page 18, lines 1-18, which discloses a substrate with the compound attached to the substrate or alternatively the compound enveloped by the substrate, or further, the compound distributed between two tissue webs. In at least the instance of the compound attached to the surface, some portion of the surface is coated with the compound. the substrate results in a topical application. How the compound is applied does not patentability distinguish the structure over the prior art. Applicant has not provided evidence and/or comparison of any unexpected result in terms of the topical application in aqueous form compared to the attached compound disclosed in the prior art. The rejection has been made in the sense of *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted), which states that when the product is claimed the patentability is defined only by the product per se, not by the process of its making and the burden is shifted to Applicant to show that the process of the prior art produces a different product. This should be presented by the factual evidence, and in the instant case the Applicant failed to show a valid side-by-side comparison between their product and the product disclosed by the Nakamura reference wherein the only difference is the process

Art Unit: 3761

of their making as per *In re Dunn*, 349 F. 2d 433, 146 USPQ 489 (CCPA 1965).

Applicant argues Nakamura does not disclose an admixture of a hydroxydiphenyl ether and an aliphatic acid, but discloses hydroxydipenyl ether amongst a length list of possibilities of phenolic compounds and further states that the preferred polymer materials are crosslinked materials. However, albeit amongst a lengthy list of possibilities, the teaching of a hydroxydipenyl ether and an aliphatic acid carrier is present in Nakamura. Regarding the preferred teaching of a crosslinked material, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994)

In response to applicant's argument that Jahnke is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case,

Art Unit: 3761

Jahnke is relied on merely to show that hexanedioic acid is an equivalent structure known in the art.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 7, 8, and 11-13 are rejected under 35 U.S.C. 102(a) as being anticipated or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Nakamura WO 99/38541.

As to claims 1, 7, 8, 11, and 12, Nakamura discloses an odor control absorbent article comprising:

Art Unit: 3761

a) a base substrate material selected from the group consisting of nonwoven fabrics, woven fabrics, polymeric films, and the combinations thereof (page 22, lines 3-17);

b) an odor control compound;

c) the odor control compound comprising an admixture of a hydroxydiphenyl ether and aliphatic acid (page 6, lines 29-32, page 8, lines 18-26) carrier. On page six, lines 14-20 of the specification applicant describes modified acid carriers capable of shifting the pH of the admixture to a range of between 3.0 and 5.0, an aliphatic acid being an example. Nakamura discloses an aliphatic acid. Therefore, it is Nakamura obviously includes a acid capable of shifting the pH of the admixture to claimed range. When the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980).

d) Nakamura discloses a substrate with the compound attached to the substrate, in which case the compound is present as a coating on at least a portion of the substrate to which it is attached (page 18, lines 1-18). The limitation the odor control present as a coating by applying the compound topically to the base substrate material

is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

e) with the base substrate material formed into a component material for a disposable sanitary product, (page 1, line 15-17, page 6, lines 29-32; page 8, lines 18-26; page 14, lines 28-34; page 18, lines 1-18; page 20, lines 7-20, and Figure 1). Regarding the limitation of the aliphatic acid carrier acting to shift the pH of the hydroxydiphenyl ether environment, and the examiner's interpretation of the performance characteristics of the instant apparatus claims, when the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980). In the present case, the reference has met the structural requirements of

Art Unit: 3761

claim by providing a base substrate with an attached compound comprising an admixture of a hydroxydiphenyl ether and an aliphatic acid carrier.

As to claims 3 and 13, Nakamura discloses the hydroxydiphenyl ether is a trichlorodiphenyl ether (page 14, lines 28-34).

As to claim 4, Nakamura discloses the modified acidic carrier is an organic acid (page 6, lines 29-32, page 8, lines 18-26).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura. Nakamura discloses the present invention substantially as claimed. However, Nakamura does not specifically disclose the odor control absorbent article is a training pant or a pull-on garment. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the odor control

Art Unit: 3761

absorbent article to include a training pant or pull-on garment as it is old and well known in the art that disposable hygiene products can include diapers, sanitary napkins, training pants, pull-on garments, and incontinence garments.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Jahnke et al. USPN 5178786. Nakamura discloses the present invention substantially as claimed except Nakamura discloses aliphatic acid. Jahnke shows that hexanedioic acid is an equivalent structure known in the art (col. 3, lines 10-12). Therefore, because these two materials were art-recognized equivalents. at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute hexanedioic acid for an aliphatic acid.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


Art Unit: 3761

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Primary Examiner
Art Unit 3761

February 20, 2007